

UNITED STATES PATENT AND TRADEMARK OFFICE

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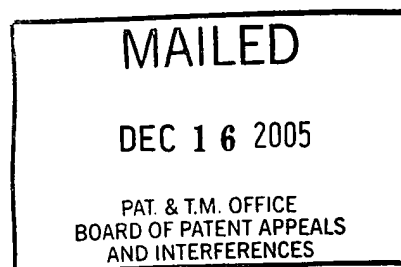
BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte LARRY W. BLAKE

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Application No. 09/631,576



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ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

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This application was electronically received at the Board of Patent Appeals and Interferences on October 27, 2005. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below.

On August 9, 2004 and January 25, 2005, appellant filed amendments to amend claims 40 and 56. A review of the file reveals that claims 40 and 56 in the appendix to the appeal brief has not been amended in accordance with the August 9, 2004 and January 25, 2005 amendments. Therefore, the appendix to the appeal brief is defective. Before further review, the

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examiner or appellant must supply claims 40 and 56 in the appendix to the appeal brief which is in accordance with the August 9, 2004 and January 25, 2005 amendments.

Also, a review of the file indicates that the appeal brief filed May 31, 2005 does not fully comply with 37 CFR § 41.37(c).

37 CFR § 41.37(c) states in part:

(c)(1) The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(I) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(I) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:

(ix) *Evidence appendix.* An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.33 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal.

(x) *Related proceedings appendix.* An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section.

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A review of the application indicates that the following appropriate sections are missing from the appeal brief filed May 31, 2005:

1) "Evidence appendix" as set forth in 37 CFR § 41.37(c)(1)(ix); and

2) "Related proceedings appendix" as set forth in 37 CFR § 41.37(c)(1)(x).

In addition, the examiner's answer mailed on August 24, 2005 is not in compliance with the requirements of 37 CFR § 41.37. The following headings need to be provided in order to be consistent with the substituted appeal brief:

*Summary of the Claimed Subject Matter* - replacing the Summary of the Invention section in paragraph (5).

*Evidence Relied Upon* - listing the prior art references.

*Acknowledgment of the Related Proceedings and Evidence appendices, if applicable.*

A supplemental appeal brief and a revised examiner's answer that is in compliance with 37 CFR § 41.37 are required. For more information on the Board's new rules see the web page entitled More Information on the Rules of Practice Before the BPAI, Final Rule at:

<http://www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html>.

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In addition, in the Grounds of Rejection section of the examiner's answer, the examiner provided reference to Lecoq, French patent 2 770 394. A review of the file reveals that a complete English translation was not provided for this reference. Before further review of this application, the examiner must submit an English translation of the complete reference.

Also, appellant filed a reply brief on October 26, 2005 in response to the examiner's answer mailed August 24, 2005. However, there is no indication on the record whether or not the examiner has responded to the reply brief. Section 1208.03 of the Manual of Patent Examining Procedure (8<sup>th</sup> ed., Aug. 2001) states:

[A]ppellant may file a reply brief as a matter of right within 2 months from the mailing date of the examiner's answer. . . . The primary must then either: (A) acknowledge receipt and entry of the reply brief by using form paragraph 12.47 on form PTOL-90; or (B) reopen prosecution to respond to the reply brief. See MPEP § 1208.02.

Accordingly, it is


ORDERED that this application be returned to the examiner to: 1) hold the appeal brief of May 31, 2005 defective; 2) correct claims 40 and 56 in the appendix of claims in the appeal brief; 3) request appellant to file a supplemental appeal brief in compliance with 37 CFR § 41.37; 4) vacate the examiner's answer and provide a revised examiner's answer in accordance with

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the new rules effective September 13, 2004 and in response to the supplemental appeal brief; 5) provide entry of an English translation for Lecoq, 2 770 394; 6) supply a copy of the translation to applicant; 7) provide proper response to the reply brief filed October 26, 2005; and 8) for such further action as may be appropriate.

It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the status of this appeal (i.e., abandonment, issue, reopening prosecution).

BOARD OF PATENT APPEALS  
AND INTERFERENCES

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